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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,311	03/22/2004	John Hermon-Taylor	117-501	9576

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EXAMINER

ZEMAN, ROBERT A

ART UNIT PAPER NUMBER

1645

DATE MAILED: 07/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/805,311	Applicant(s) HERMON-TAYLOR ET AL.	
	Examiner Robert A. Zeman	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-69 is/are pending in the application.
- 4a) Of the above claim(s) 66-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 49-69 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/091,538.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3-22-04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The amendment filed on 2-10-2005 is acknowledged. Claims 24-28 have been canceled. Claims 49-69 have been added.

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number and its current status.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The use of the trademark Tween has been noted in this application (see page 30 for example). It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Information Disclosure Statement

The information disclosure statement filed 3-22-2005 has been considered. An initialed copy is enclosed.

Election/Restrictions

Applicant's election with traverse of Group I in the paper filed on 2-10-2005 is acknowledged. The traversal is on the ground(s) that search and examination of the claimed inventions would not constitute an undue burden on the examiner. This is not found persuasive

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because the searches of the various groups would not be coextensive in scope and as such would constitute an undue burden.

The requirement is still deemed proper and is therefore made FINAL.

Claims 66-69 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Claims 49-65 are currently under examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 49-65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejected claims are drawn to polynucleotides that encode a polypeptide capable of stimulating an immune response a mycobacterium. In other words, the immune response generated is to the mycobacterium, not just the polypeptide encoded by the polynucleotide.

The claims are drawn to a vast genus of polynucleotides wherein said polynucleotide comprises SEQ ID NO:23, is capable of selectively hybridizing to SEQ ID NO:23, has at least 80% homology to SEQ ID NO:23 over 30 amino acid residues, encodes the polypeptide of SEQ

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ID NO:24 or a fragment of at least 10 amino acids of the polypeptide of SEQ ID NO:24. All said polynucleotides must be able to stimulate an immune response to a mycobacterium. To fulfill the written description requirements set forth under 35 USC § 112, first paragraph, the specification must describe at least a substantial number of the members of the claimed genus, or alternatively describe a representative member of the claimed genus, which shares a particularly defining feature common to at least a substantial number of the members of the claimed genus, which would enable the skilled artisan to immediately recognize and distinguish its members from others, so as to reasonably convey to the skilled artisan that Applicant has possession the claimed invention. To adequately describe the genus of polynucleotides (as described above) that stimulate an immune response to a mycobacterium, Applicant must adequately describe the antigenic determinants (immunoepitopes) that elicit an immune response directed against the mycobacterium not just those determinants that would elicit an immune response to the polypeptide encoded by said polynucleotide. A given polypeptide can be immunogenic but not induce an immune response directed against a mycobacterium.

However, the specification does not disclose distinguishing and identifying features of a representative number of members of the genus of polynucleotides (or the polypeptides they encode) to which the claims are drawn, such as a correlation between the structure of the immunoepitope and its recited function (to elicit an immune response directed against a mycobacterium), so that the skilled artisan could immediately envision, or recognize at least a substantial number of members of the claimed genus of polynucleotides. Moreover, the specification fails to disclose which amino acid residues of the encoded polypeptides are essential to the function of the immunoepitope or which amino acids might be replaced or

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deleted so that the resultant immunoepitope retains the activity of its parent, or by which other amino acids the essential amino acids might be replaced so that the resultant immunoepitope retains the activity of its parent. Therefore, since the specification fails to adequately describe at least a substantial number of members of the genus of immunoepitopes to which the claims are based; the specification fails to adequately describe at least a substantial number of members of the claimed genus of polynucleotides capable of stimulating an immune response to a mycobacterium.

MPEP § 2163.02 states, “[a]n objective standard for determining compliance with the written description requirement is, ‘does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed’ ”. The courts have decided:

The purpose of the “written description” requirement is broader than to merely explain how to “make and use”; the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the “written description” inquiry, *whatever is now claimed*.

See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Federal Circuit, 1991). Furthermore, the written description provision of 35 USC § 112 is severable from its enablement provision; and adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993) and Amgen Inc. V. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016.

The Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, paragraph 1, “Written Description” Requirement (66 FR 1099-1111, January 5, 2001) state, “[p]ossession may be shown in a variety of ways including description of an actual reduction to

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practice, or by showing the invention was 'ready for patenting' such as by disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention" (*Id.* at 1104). Moreover, because the claims encompass a genus of variant species, an adequate written description of the claimed invention must include sufficient description of at least a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics sufficient to show that Applicant was in possession of the claimed genus. However, factual evidence of an actual reduction to practice has not been disclosed by Applicant in the specification; nor has Applicant shown the invention was "ready for patenting" by disclosure of drawings or structural chemical formulas that show that the invention was complete; nor has Applicant described distinguishing identifying characteristics sufficient to show that Applicant were in possession of the claimed invention at the time the application was filed.

The *Guidelines* further state, "[f]or inventions in an unpredictable art, adequate written description of a genus which embraces widely variant species *cannot* be achieved by disclosing only one species within the genus" (*Id.* at 1106); accordingly, it follows that an adequate written description of a genus cannot be achieved in the absence of a disclosure of at least one species within the genus.

As evidenced by Greenspan et al. (*Nature Biotechnology* 7: 936-937, 1999), defining epitopes is not as easy as it seems. Greenspan et al. recommends defining an epitope by the structural characterization of the molecular interface between the antigen and the antibody is necessary to define an "epitope" (page 937, column 2). According to Greenspan et al., an

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epitope will include residues that make contacts with a ligand, here the antibody, but are energetically neutral, or even destabilizing to binding. Furthermore, an epitope will not include any residue not contacted by the antibody, even though substitution of such a residue might profoundly affect binding. Accordingly, it follows that the immunoepitopes that can elicit an immune response to a given pathogen can only be identified empirically. Therefore, absent a detailed and particular description of a representative number, or at least a substantial number of the members of the genus of immunoepitopes, the skilled artisan could not immediately recognize or distinguish members of the claimed genus of immunogenic compositions capable of stimulating an immune response in an animal *to* a mycobacterium (as opposed to the polypeptide encoded by the polynucleotide) Therefore, because the art is unpredictable, in accordance with the *Guidelines*, the description of immunoepitopes (antigenic determinants) is not deemed representative of the genus of immunogenic compositions to which the claims refer.

Claims 49-65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The rejected claims are drawn to polynucleotides that encode a polypeptide capable of stimulating an immune response a mycobacterium wherein said polynucleotide comprises SEQ ID NO:23, is capable of selectively hybridizing to SEQ ID NO:23, has at least 80% homology to SEQ ID NO:23 over 30 amino acid residues, encodes the polypeptide of SEQ ID NO:24 or a fragment of at least 10 amino acids of the polypeptide of SEQ ID NO:24. However, Applicant

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has failed to demonstrate any polynucleotides (based on SEQ ID NO:23) that encode polypeptides based on SEQ ID NO:24 that are capable of eliciting the claimed immune response (an immune response directed against a mycobacterium itself not just the polypeptide). While the skill in the art of immunology is high, to date, prediction of a specific immune response for any given composition in any given animal is quite unpredictable. Moreover, protein chemistry is probably one of the most unpredictable areas of biotechnology. Consequently, the effects of sequence dissimilarities upon protein structure and function cannot be predicted. Bowie et al (Science, 1990, 257:1306-1310) teach that an amino acid sequence encodes a message that determines the shape and function of a protein and that it is the ability of these proteins to fold into unique three-dimensional structures that allows them to function, carry out the instructions of the genome **and form immunoepitopes**. Bowie et al. further teach that the problem of predicting protein structure from sequence data and in turn utilizing predicted structural determinations to ascertain functional aspects of the protein is extremely complex. (column 1, page 1306). Bowie et al further teach that while it is known that many amino acid substitutions are possible in any given protein, the position within the protein's sequence where such amino acid substitutions can be made with a reasonable expectation of maintaining function are limited. Certain positions in the sequence are critical to the three dimensional structure/function relationship and these regions can tolerate only conservative substitutions or no substitutions (column 2, page 1306). Additionally, as evidenced by Greenspan et al. (*Nature Biotechnology* 7: 936-937, 1999), defining epitopes is not as easy as it seems. Greenspan et al. recommends defining an epitope by the structural characterization of the molecular interface between the antigen and the antibody is necessary to define an "epitope" (page 937, column 2). According to Greenspan et al., an epitope will include residues that make contacts with a ligand,

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here the antibody, but are energetically neutral, or even destabilizing to binding. Furthermore, an epitope will not include any residue not contacted by the antibody, even though substitution of such a residue might profoundly affect binding. Accordingly, it follows that the immunoepitopes that can elicit an immune response to a given pathogen can only be identified empirically. This constitutes undue experimentation. Therefore, given the lack of success in the art, the lack of working examples commensurate in scope to the claimed invention and the unpredictability of the generation of directed immune response, the specification, as filed, does not provide enablement for polynucleotides encoding for polypeptides capable of stimulating an immune response to a mycobacterium. Moreover, it should be noted that the rejected claims read on DNA vaccines but the specification is silent as to what nucleic acids would encode polypeptides that would elicit a protective immune response against mycobacterium. Additionally, even though one would expect the polypeptide encoded by SEQ ID NO:23 (i.e. the polypeptide with the sequence of SEQ ID NO:24) to elicit an immune response one would not be able to predict whether said immune response would be directed to a mycobacterium or whether said response would be protective. One would be equally unable to predict whether polypeptides comprising "variations" or fragments of SEQ ID NO:23 or SEQ ID NO:24 would elicit a directed or protective immune response. Hence, with regard to the use of vaccines, the specification is not enabling.

Conclusion

No claim is allowed

SEQ ID NO:23 and 24 are free of the art of record.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is 571-272-0866. The examiner can normally be reached on M-Th 7:00 am - 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 571-272-0864.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



ROBERT A. ZEMAN
PATENT EXAMINER
July 21, 2005